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<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	09/768,658
	Filing Date	January 23, 2001
	First Named Inventor	Jeremy Kenyon
	Art Unit	2192
	Examiner Name	Nguyen-Ba, Hoang-Vu A.
Total Number of Pages in This Submission	Attorney Docket Number	

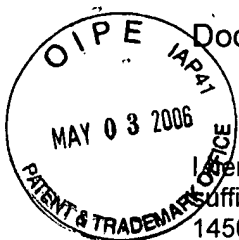
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Docket No.: 109910-130358

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By: Yvette L. Chriscaden Date: May 1, 2006  
Yvette L. Chriscaden

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**Before the Board of Patent Appeals and Interferences**

App. No. : 09/768,658 Confirmation No.: 3790  
Inventor : Kenyon et al.  
Filed : January 23, 2001  
Title : ASYNCHRONOUS SOFTWARE UPDATE  
Art Unit : 2192  
Examiner : Nguyen Ba, Hoang Vu A.  
Customer No. : 25,943

**MAIL STOP: APPEAL BRIEF-PATENTS**  
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**RESUBMISSION OF APPELLANT'S BRIEF IN SUPPORT OF APPELLANT'S  
APPEAL TO THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Dear Sir:

This is a re-submission of Appellant's Brief in response to the Non-Compliant Notice mailed on April 5, 2006. The deficiency has been corrected. This appeal furthers the Notice of Appeal filed on December 28, 2005. The appeal arises from a final decision by the Examiner in the final Office Action, dated September 28, 2005. The final decision was in response to arguments filed on June 30, 2005, in response to an earlier office action, mailed March 31, 2005.

Appellants re-submit this *Brief on Appeal*. Payment in the amount of \$500.00 to cover the fee for filing the *Brief on Appeal* was tendered with the original submission.

Appellants respectfully request consideration of this appeal by the Board of Patent Appeals and Interferences for allowance of the present patent application.

**Real Party in Interest:**

This application is assigned to WildTangent, Inc., having a principal place of business at 18578 NE 67th Ct., Redmond, Washington 98052. The assignment is recorded at the United States Patent and Trademark Office, reel 014650, frame 0253.

**Related Appeals and Interferences:**

To the best of Appellants' knowledge, there are no related appeals or interference proceedings currently pending, which would directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

**Status of Claims:**

Appellants appeal the rejection of claims 1-24. Claims 1-24 were pending and were rejected in the Final Office Action dated September 28, 2005. Claims 1-24 are reproduced, as pending, in Appendix A.

**Status of Amendments:**

Appellants have made no amendments subsequent to the Examiner's final rejection.

**Summary of the Claimed Subject Matter:**

Independent claim 1 is directed towards *a method of operation in a server* that comprises "accepting check in by a client computer at a first point in time to determine if the client computer's software needs to be updated; and providing the client computer with an update task list listing one or more tasks to be performed by the client computer asynchronously at a later point or later points in time to update the client computer's software, if it is determined that the client computer's software is to be updated."

Element 102 of Figure 1a illustrates one example of a software supplier server performing the operations recited in claim 1. Element 102 of Figure 1a is described in detail on page 6, line 7 through page 7, line 3, in accordance with some embodiments. Figure 1b illustrates a flowchart of selected operations of the present invention in accordance with claim 1. The selected operations illustrated by Figure 1b are described in greater detail on page 7, line 4 through page 8, line 21, in accordance with some embodiments. Figures 4a-4b also illustrate a flowchart of selected operations of the present invention in accordance with claim 1. The selected operations illustrated by Figures 4a-4b are described in greater detail on page 14, line 15 through page 16, line 3.

Independent claim 8 is directed towards a method of operation in a client, having similar limitations to those found in claim 1. Therefore, support can be found in the same figures and passages in the specification enumerated in the above paragraph. Such a client is illustrated as element 132 of Figure 1a, the page and line numbers for the description of Figure 1a given above. Additional support can also be found in Figures 2a-2b, an illustration of a flowchart of selected operations of the client in accordance with claim 8. The selected operations illustrated by Figures 2a-2b are described in greater detail on page 9, line 2 through page 14, line 12, in accordance with some embodiments.

Independent claim 12 is directed towards *an apparatus* which, in substance, is claim 1 in apparatus form. Therefore, support can be found in the same figures and passages in the specification enumerated in the preceding paragraph summarizing claim 1. Further, additional support can be found in Figure 6 and its corresponding description on page 17, line 11 through page 18, line 2. Figure 6 illustrates an exemplary computer system capable of performing the operations recited in claim 1, in accordance with some embodiments.

Independent claim 20 is directed towards *an apparatus* which, in substance, is claim 8 in apparatus form. Therefore, support can be found in the same figures and passages in the specification enumerated in the preceding paragraph summarizing claim 8. Further, additional support can be found in Figure 6 and its corresponding description on page 17, line 11 through page 18, line 2. Figure 6 illustrates an exemplary computer system capable of performing the operations recited in claim 8, in accordance with some embodiments.

**Grounds for Rejection to Be Argued On Appeal:**

I. Whether claims 1-24 are patentable under 35 U.S.C. §102(e) over the teachings of U.S. Patent Publication No. 2002/0100036 A1 to *Moshir et al.* (hereinafter “Moshir”).

**Arguments:**

I. Rejection of claims 1-24 under 35 U.S.C. §102(e) was improper because Moshir is unavailable as a prior art reference under §102(e).

As Appellants noted in their response of October 31, 2005, Moshir was filed on September 20, 2001, about eight months after the instant application. However, Moshir also claims the priority of Provisional Application No. 60/234,680, originally filed September 22, 2000, under 35 U.S.C. § 119(e), less than four months before the instant application was filed. Accordingly, Moshir must find support for each of the portions referenced in the Office Actions in Provisional Application No. 60/234,680.

Even assuming *arguendo* that the cited portions of Moshir are properly supported, Appellants have, in response, submitted a Declaration under 37 C.F.R. § 1.131, supported by corroborating evidence. Both the Declaration and the corroborating evidence are reproduced as attachments to Appendix B of this brief. The Declaration and evidence establish a “reduction to practice” by Appellants prior to September 22, 2000.

The enclosed corroborating evidence comprises a summary of available new features that the patent attorney received from the inventors in the document entitled "Update Service v1.5 Feature List," created by inventor Geoffrey K. Bauman and dated July 18, 2000. Appellants also respectfully note that "Update Service v1.5 Features List" includes features from both version 1.1 and version 1.5 of the Update Service and that those features of version 1.5 were the new features being explained in the July 18, 2000 document.

Despite the Declaration and evidence, the Examiner, in the final Office Action dated September 28, 2005, has maintained the rejection made in the prior March 31, 2005 Office Action. One reason given by the Examiner for maintaining the rejection was that the corroborating evidence provided by Appellants antedated the Moshir reference by only two months and four days. The Examiner suggested that this time period is insufficient to overcome a rejection because Moshir could equally submit an affidavit under 37 C.F.R. § 1.131 antedating Appellants' date of July 18, 2000. Appellants respectfully suggest that Moshir's ability to antedate Appellants' July 18, 2000 date is not relevant (see, e.g., MPEP 715). MPEP 715 states that, in an *ex parte* proceeding such as this, the relevant date that an applicant submitting a 37 C.F.R. § 1.131 must swear behind is the prior art date of the reference under 35 U.S.C. § 102(e). Moshir's prior art date under § 102(e) is September 22, 2000. Thus, any affidavit under § 1.131 accompanied by sufficient corroborating evidence establishing a date prior to September 22, 2000 would be sufficient to overcome a rejection under Moshir. Accordingly, Appellants renew their submission that Moshir is unavailable.

Additionally, the Examiner gave as a further reason for sustaining the above-mentioned rejection the insufficiency of the corroborating evidence supporting Appellants' Declaration. Appellants respectfully submit, contrary to the Examiner's suggestion, that the features claimed in claims 1-24 are present in "Update Service v1.5 Feature List."

Claim 1, for example, requires that a server “accept[] check in by a client computer at a first point in time to determine if the client computer’s software needs to be updated.” This operation is fully supported by paragraph 1 on page 2 of the “Update Service v1.5 Feature List,” which provides that “[a]fter its initial install, [the client] checks into the Update server and checks for newer versions . . . .”

Claim 1 further requires that a server “provid[e] the client computer with an update task list listing one or more tasks to be performed by the client computer asynchronously at a later point or later points in time to update the client computer’s software, if it is determined that the client computer’s software is to be updated.” The “update task list,” though not explicitly referenced, is sufficiently contained by inference within the “Update Service v1.5 Feature List.” Any reply from a server indicating that more than one update should be downloaded would satisfy the requirement that the server provide the client computer with an update task list. Such a reply is disclosed in paragraph 5 on page 3 of the document, where a client signs up for updates to some category of test applications, and when the test applications become available, a client checking in is notified of them and updated to them.

The asynchronous performance of update tasks at a later time or times is also disclosed at least in paragraph 5 on page 2 of the document, which provides for completion at a later time of an installation, if the installation requires the replacement of a file that is in use at the time of installation.

Accordingly, Moshir is believed to be unavailable as a prior art reference against the present invention, as claimed.

II. Rejection of claims 1-24 under 35 U.S.C. §102(e) was improper because Moshir fails to anticipate the invention as claimed in claims 1-24.

It is well settled that anticipation under 35 U.S.C. §102 requires the disclosure in a single piece of prior art to teach each and every limitation of a claimed invention. *Electro Med. Sys. S.A. v. Cooper Life Sciences*, 34 F.3d 1048, 1052, 32 USPQ2d 1017, 1019 (Fed. Cir. 1994). . MPEP 2131 states, "TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM" and "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Furthermore, anticipation requires that each claim element must be identical to a corresponding element in the applied reference. *Glaverbel Société Anonyme v. Northlake Mktg & Supply, Inc.*, 45 F.3d 1550, 1554 (Fed. Cir. 1995). Thus, to anticipate the present invention as claimed in claims 1-24, Moshir must disclose every element recited in the pending claims.

Claim 1 calls for, in a server, a method of operation comprising:  
accepting check in by a client computer at a first point in time to determine if the  
client computer's software needs to be updated; and  
providing the client computer with an update task list listing one or more tasks to  
be performed by the client computer asynchronously at a later point or  
later points in time to update the client computer's software, if it is  
determined that the client computer's software is to be updated.

Moshir teaches a method of "discovering software updates, discovering if a given computer can use the software update, and then updating the computers with the software as needed automatically across a network without storing the updates on an intermediate machine within the network." The process is facilitated by an update agent



executing on the target computers (the computers to be updated). The update agent contacts an update server to retrieve from the server a list of update tasks the target computer needs to perform. Upon retrieving a list, the agent begins to automatically download the needed update.

In contrast, the present invention, as claimed in claim 1, recites performing the update “asynchronously, at a later point or later points in time.” Nothing in Moshir teaches or even hints at asynchronous or delayed performance of update tasks by the client computer. The only delays referenced in Moshir are delays by the server in performing its functions (Moshir, paragraphs 61-62). The target computer of Moshir, through its update agent, is not shown to perform the update tasks provided to it “asynchronously, at a later point or later points in time.” Thus, Moshir fails to disclose, in as complete detail as is claimed in claim 1, performing the update “asynchronously, at a later point or later points in time.”

Accordingly, claim 1 is patentable over Moshir.

Claim 13 recites an apparatus performing the operations recited in claim 1. Thus, for at least the same reasons, claim 13 is patentable over Moshir.

Claims 2-12 and 14-24 depend from claims 1 and 13, incorporating their limitations respectively. Accordingly, for at least the same reasons, claims 2-12 and 14-24 are patentable over Moshir.

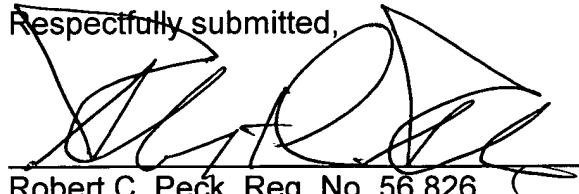
### **Conclusion**

Appellants respectfully submit that all the appealed claims in this application are patentable and requests that the Board of Patent Appeals and Interferences overrule the Examiner and direct allowance of the rejected claims.

This brief is re-submitted. We do not believe any additional fees, in particular extension of time fees, are needed. However, should that be necessary, please charge our deposit account 500393. In addition, please charge any shortages and credit any overages to Deposit Account No. 500393.

Date: May 1, 2006

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'R. C. Peck', written over a horizontal line.

Robert C. Peck, Reg. No. 56,826  
Agent for Appellant Applicants

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## **Appendix A – Appealed Claims**

1. (Original) In a server, a method of operation comprising:  
accepting check in by a client computer at a first point in time to determine if the client computer's software needs to be updated; and  
providing the client computer with an update task list listing one or more tasks to be performed by the client computer asynchronously at a later point or later points in time to update the client computer's software, if it is determined that the client computer's software is to be updated.
2. (Original) The method of claim 1, wherein the method further comprises determining if the client computer's software needs to be updated.
3. (Original) The method of claim 1, wherein said one or more tasks to be performed by the client computer asynchronously at a later point or later points in time to update the client computer's software comprise re-contacting the server at a later point or later points in times to retrieve one or more software parts.
4. (Original) The method of claim 1, wherein said one or more tasks to be performed by the client computer asynchronously at a later point or later points in time to update the client computer's software comprise contacting one or more third part servers at a later point or later points in times to retrieve one or more software parts.
5. (Original) The method of claim 1, wherein said one or more tasks to be performed by the client computer asynchronously at a later point or later points in time to update the client computer's software comprise one or more installation tasks to be

performed asynchronously at a later point or later points in time upon asynchronously obtaining one or more software parts.

6. (Previously Presented) The method of claim 1, wherein the method further comprises servicing one or more subsequent asynchronous requests from the client computer for software parts in accordance with the tasks listed in said task list.

7. (Original) The method of claim 6, wherein said servicing comprises asking the client computer to retry one or more of the subsequent asynchronous requests for software parts.

8. (Original) In a client computer, a method of operation comprising:  
periodically checking in with a server to determine if the client computer's software needs to be updated;  
receiving from the server an update task list listing one or more tasks to be performed by the client computer asynchronously at a later point or later points in time to update the client computer's software, upon determining the client computer's software needs to be updated; and  
performing said one or more tasks asynchronously at a later point or later points in time to update the client computer's software.

9. (Original) The method of claim 8, wherein said one or more tasks to be performed by the client computer asynchronously at a later point or later points in time to update the client computer's software comprise re-contacting the server at a later point or later points in times to retrieve one or more software parts.

10. (Original) The method of claim 8, wherein said one or more tasks to be performed by the client computer asynchronously at a later point or later points in time to update the client computer's software comprise contacting one or more third part servers at a later point or later points in times to retrieve one or more software parts.

11. (Original) The method of claim 8, wherein said one or more tasks to be performed by the client computer asynchronously at a later point or later points in time to update the client computer's software comprise one or more installation tasks to be performed asynchronously at a later point or later points in time upon asynchronously obtaining one or more software parts.

12. (Original) The method of claim 8, wherein the method further comprises scheduling asynchronous performance of said tasks.

13. (Original) An apparatus comprising:

storage medium having stored therein a plurality of programming instructions designed to accept check in by a client computer at a first point in time to determine if the client computer's software needs to be updated, and to provide the client computer with an update task list listing one or more tasks to be performed by the client computer asynchronously at a later point or later points in time to update the client computer's software, if it is determined that the client computer's software is to be updated; and

at least one processor coupled to the storage medium to execute the programming instructions.

14. (Original) The apparatus of claim 13, wherein the programming instructions are further designed to determine whether the client computer's software needs to be updated.

15. (Previously Presented) The apparatus of claim 13, wherein said one or more tasks to be performed by the client computer asynchronously at a later point or later points in time to update the client computer's software comprise re-contacting the apparatus at a later point or later points in times to retrieve one or more software parts.

16. (Original) The apparatus of claim 13, wherein said one or more tasks to be performed by the client computer asynchronously at a later point or later points in time to update the client computer's software comprise contacting one or more third part servers at a later point or later points in times to retrieve one or more software parts.

17. (Original) The apparatus of claim 13, wherein said one or more tasks to be performed by the client computer asynchronously at a later point or later points in time to update the client computer's software comprise one or more installation tasks to be performed asynchronously at a later point or later points in time upon asynchronously obtaining one or more software parts.

18. (Previously Presented) The apparatus of claim 13, wherein the programming instructions are further designed to service one or more subsequent asynchronous requests from the client computer for software parts in accordance with the tasks listed in said task list.

19. (Original) The apparatus of claim 18, wherein said programming instructions are further designed to ask the client computer to retry one or more of the subsequent asynchronous requests for software parts.

20. (Original) A client computer comprising:

storage medium having stored therein a plurality of programming instructions designed to periodically check in with a server to determine if the client computer's software needs to be updated, to receive from the server an update task list listing one or more tasks to be performed by the client computer asynchronously at a later point or later points in time to update the client computer's software, upon determining the client computer's software needs to be updated, and to perform said one or more tasks asynchronously at a later point or later points in time to update the client computer's software; and

at least one processor coupled to the storage medium to execute the programming instructions.

21. (Original) The client computer of claim 20, wherein said one or more tasks to be performed by the client computer asynchronously at a later point or later points in time to update the client computer's software comprise re-contacting the server at a later point or later points in times to retrieve one or more software parts.

22. (Original) The client computer of claim 20, wherein said one or more tasks to be performed by the client computer asynchronously at a later point or later points in time to update the client computer's software comprise contacting one or more third part servers at a later point or later points in times to retrieve one or more software parts.

23. (Original) The client computer of claim 20, wherein said one or more tasks to be performed by the client computer asynchronously at a later point or later points in time to update the client computer's software comprise one or more installation tasks to be performed asynchronously at a later point or later points in time upon asynchronously obtaining one or more software parts.

24. (Original) The client computer of claim 20, wherein the programming instructions are further designed to schedule asynchronous performance of said tasks.





## **Appendix B – Copies of Evidence Submitted**

Attached please find a copy of Appellants' Declaration submitted under 37 C.F.R. § 1.131, dated June 30, 2005, establishing a reduction to practice prior to September 22, 2000, and evidence of that prior reduction to practice in the form of the document entitled "Update Service v1.5 Feature List," dated July 18, 2000.



## **Appendix C – Related Proceedings**

There are no related appeals or interference proceedings currently pending, which would directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.